

REMARKS:

REMARKS REGARDING CLAIM AMENDMENTS:

Please cancel claims 5 and 15 without prejudice. The claims have been amended so that the scope and language of the claims is clearer and more precise in defining what the Applicant considers to be the invention. Specifically, claims 1, 11, and 51 have been amended to incorporate the subject matter previously contained in cancelled claims 5 and 54. Support for the above amendments can be found at least claim 5 of the original specification as filed. Claim 53 has been amended to correct spelling mistake.

Applicant respectfully submits that the claims as amended are clearly distinct and patentable over the prior art of record and therefore respectfully request that they be allowed.

IN RESPONSE TO THE OFFICE ACTION:

1ST REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1–5, 7, 10–16, 51–54, and 57 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 3,683,928 to Kuntz (“Kuntz”). Claims 3–5, 13–14, and 54 have been cancelled. Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claims 1, 11, and 51 and the following remarks.

As amended, independent claims 1, 11, and 51 each require a catheter dispensing system having only a single chamber. Kuntz does not disclose, teach, or suggest a catheter dispensing system having a single chamber. Instead, Kuntz discloses having multiple chambers. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of claims 1, 11, and 51.

Claims 2, 7, 10, 12, 15–16, 52–53, and 57 depend from claims 1, 11, and 51 and necessarily incorporate each limitation therein. Therefore, claims 2, 7, 10, 12, 15–16, 52–53, and 57 are allowable for at least the same reason as independent claims 1, 11, and 51. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 2, 7, 10, 12, 15–16, 52–53, and 57.

2ND REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1, 8, 10–11, and 15–16 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 3,995,628 to Gula et al. (“Gula”). Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claims 1 and 11 and the following remarks.

As amended, independent claims 1 and 11 each require a catheter dispensing system having only a single chamber. Gula does not disclose, teach, or suggest a catheter dispensing system having a single chamber. Instead, Gula discloses a catheter dispensing system that has two chambers. Specifically, Gula discloses a container having an outer circumferential wall and an inner cylindrical wall. The inner wall defines an annular space between the inner and outer walls. [see col. 4, ll. 12–15.] A gap is provided so that the catheter can move from the inner chamber to the annular chamber. [see col. 4, ll. 18–22.] Applicant therefore respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of claims 1 and 11.

Claims 8, 10, and 15–16 depend from claims 1 and 11 and necessarily incorporate each limitation therein. Therefore, claims 8, 10, and 15–16 are allowable for at least the same reason as independent claims 1 and 11. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 8, 10, and 15–16.

3RD REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1, 7, 10–11, 51–52, and 57 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent 3,561,445 to Katerndahl et al. (“Katerndahl”). Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claims 1, 11, and 51 and the following remarks.

As amended, independent claims 1, 11, and 51 each require a catheter dispensing system having a semi-rigid dispenser. Katerndahl does not disclose, teach, or suggest a catheter dispensing system having a semi-rigid dispenser. Instead, Katerndahl discloses a dispenser composed of flexible tubing. The flexibility of the dispenser is needed for the pulling the catheter from the container. [see col. 4, l. 50 – col. 5, l. 12] Applicant therefore respectfully

requests that the Examiner reconsider and withdraw the § 102(b) rejection of claims 1, 11, and 51.

Claims 7, 10, 52, and 57 depend from claims 1, 11, and 51 and necessarily incorporate each limitation therein. Therefore, claims 7, 10, 52, and 57 are allowable for at least the same reason as independent claims 1, 11, and 51. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 7, 10, 52, and 57.

1ST REJECTION UNDER 35 U.S.C. § 103(a):

Claims 6 and 55 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kuntz or Katerndahl. Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claims 1 and 51 and the following remarks.

The fundamental basis for an obviousness determination under 35 U.S.C. § 103(a) was set forth by the Supreme Court in *Graham v. John Deere Co.*, 383 US 1; 148 U.S.P.Q. 459. In subsequent cases involving a determination of obviousness under 35 U.S.C. § 103, the Federal Circuit has noted that the following basic tenets of patent law must be adhered to: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole and must suggest the desirability and, thus, the obviousness of making the combination; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187, n.5 (Fed. Cir. 1986). All of the claim limitations must be taught in order to establish obviousness. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As discussed above, claims 1 and 51 require a limitation not disclosed, taught, or suggested by Kuntz. Namely, that the catheter dispensing system have only a single chamber. Likewise, claims 1 and 51 require that the dispenser be semi-rigid which is not disclosed, taught, or suggested by Katerndahl. Further, it would not be obvious to combine Kuntz with Katerndahl, as the very operation of Kuntz requires multiple chambers.

Claims 6 and 55 depend from claims 1 and 51 and necessarily incorporate each limitation therein. Therefore, claims 6 and 55 are allowable for at least the same reason as independent

claims 1 and 51. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 6 and 55.

2ND REJECTION UNDER 35 U.S.C. § 103(a):

Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gula. Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claim 1 and the following remarks.

As discussed above, claim 1 requires a limitation not disclosed, taught, or suggested by Gula. Namely, that the catheter dispensing system have only a single chamber. Claim 6 depends from claim 1 and necessarily incorporates each limitation therein. Therefore, claim 6 is allowable for at least the same reasons as independent claim 1. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claim 6.

3RD REJECTION UNDER 35 U.S.C. § 103(a):

Claims 8–9 and 56 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kuntz. Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendments to claims 1 and 51 and the following remarks.

As discussed above, claims 1 and 51 require a limitation not disclosed, taught, or suggested by Kuntz. Namely, that the catheter dispensing system have only a single chamber. Claims 8–9 and 56 depend from claims 1 and 51 and necessarily incorporate each limitation therein. Therefore, claims 8–9 and 56 are allowable for at least the same reasons as independent claims 1 and 51. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claim 8–9 and 56.

4TH REJECTION UNDER 35 U.S.C. § 103(a):

Claim 9 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gula. Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claim 1 and the following remarks.

As discussed above, claim 1 requires a limitation not disclosed, taught, or suggested by Gula. Namely, that the catheter dispensing system have only a single chamber. Claim 9 depends from claim 1 and necessarily incorporates each limitation therein. Therefore, claim 9 is allowable for at least the same reasons as independent claim 1. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claim 9.

5TH REJECTION UNDER 35 U.S.C. § 103(a):

Claims 9 and 56 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Katerndahl. Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claims 1 and 51 and the following remarks.

As discussed above, claims 1 and 51 each require a limitation not disclosed, taught, or suggested by Gula. Namely, that the dispenser be semi-rigid. Claims 9 and 56 depend from claims 1 and 51 and necessarily incorporate each limitation therein. Therefore, claims 9 and 56 are allowable for at least the same reasons as independent claims 1 and 51. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 9 and 56.

6TH REJECTION UNDER 35 U.S.C. § 103(a):

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kuntz. Applicant requests that the Examiner reconsider and withdraw the rejection in view of the amendment to claim 11 and the following remarks.

As discussed above, claims 11 requires a limitation not disclosed, taught, or suggested by Kuntz. Namely, that the catheter dispensing system have only a single chamber. Claims 17 and 58 depend from claim 11 and necessarily incorporate each limitation therein. Therefore, claims 17 and 18 are allowable for at least the same reasons as independent claim 11. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claim 17 and 18.

Serial No.: 09/989,342
Confirmation No.: 5345
Applicant: Robert C. Simpson
Atty. Ref.: 13421.0002.NPUS00

Applicant invites the Examiner to contact the undersigned attorney by telephone to discuss any issues or questions presented by this paper.

Respectfully submitted,

Robert J. McLaughan, Jr.
Patent Attorney
Reg. No. 36,599
Tel. (713) 787-1637
Date: 8-17-04